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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,073	12/12/2003	David M. Howard	12842-0006	1262

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EXAMINER

ELKINS, GARY E

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

08

Office Action Summary

Application No.

10/735,073

Applicant(s)

HOWARD, DAVID M.

Examiner

Gary E. Elkins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a) because they fail to delineate between the score lines and cut lines forming the blank as described in the specification. The drawings illustrate both the score lines and cut lines as solid lines which would be confusing to anyone unfamiliar with box manufacture where the location of the cuts and scores is important to understand how the box is formed from the blank. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the embodiments as set forth in claims 2-4, 8 and 9 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Specifically, the drawings fail to show an embodiment where the front wall of the top segment includes projections for fitting into slots in the "side walls" of the main top segment as set forth in claim 2. Note is made that the projections 172, 173 in fig. 3 fit into slots in the projecting tab portions L, L' rather than in the side walls K, K'. The drawings fail to show an embodiment where the container includes both an interior detail and an adhesive material between the side walls as set forth in claims 3, 4, 8 and 9.

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A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: no antecedent basis can be found in the specification for the subject matter set forth in claims 2-4, 8 and 9.

Claim Objections

4. Applicant is advised that should claim 5 be found allowable, claim 7 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

5. Claims 2-4, 8 and 9 is rejected under 35 USC 112, 1st paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification provides no description nor can it be seen how one can make the embodiments of these claim, i.e. the specification lacks enablement with respect to the embodiments where the sidewalls of the top segment include slots which receive projections extending from the front panel of the top

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segment and the specification fails to disclose how to make the embodiment of fig. 1, i.e. the embodiment including adhesive material affixing the walls, with an interior detail as part of the front panel of the bottom segment.

6. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the preamble in each of claims 1 and 7, it is unclear what is being defined as "comprising", i.e. the container or the single piece of foldable corrugated cardboard.

In line 9 in each of claims 1 and 7, "said front walls" is unclear within the context of the claim, i.e. the folded front walls do not appear to be forming a recess between all of the front walls previously defined since "said front walls" would also include the front wall defined in line five.

In each of claims 1 and 7, lines 9 and 10, "said side walls" is unclear since this phrase includes all the side walls previously defined, i.e. the side walls of the bottom and top segments.

In each of claims 1 and 7, line 10, "the end of the side walls" is indefinite insofar as all of the sidewalls do not include a single or common end.

In each of claims 1 and 7, line 11, "said recess between said folded front panels" and "said folded front panels" each lack antecedent basis in the claims. The recess was previously defined between the folded front walls. No plurality of "folded front panels" were previously defined.

In claim 2, the recitation that the folded front panel of the top segment includes projections for fitting within slots in the side walls is unclear since the only embodiments disclosed include slots in the projecting tab portions rather than the side walls.

In each of claims 13, 14, 17 and 18, "one or more golf ball four-packs" is a double inclusion of an element insofar as the "article" was previously defined in claims 1 and 7.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 5, 7, 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Drinon or Wittstein (fig. 7 emb), each in view of Vance. Each of Drinon and Wittstein discloses all structure of the claimed container except a front panel including an interior detail. Vance teaches that it is known to make a tray with an interior detail (10-12) folded from a front panel to securely hold and display an item in the container. It would have been obvious to make the tray in either Drinon or Wittstein with an interior detail as taught by Vance for the purpose of securely holding and displaying an item within the container.

9. Claims 1, 5, 7, 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Drinon or Wittstein (fig. 7 emb), each in view of Johnson. Each of Drinon and Wittstein discloses all structure of the claimed container except a front panel including an interior detail. Johnson teaches that it is known to make a tray with an interior detail (30) folded from a front panel to securely hold and display an item in the container. It would have been obvious to make

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the tray in either Drinon or Wittstein with an interior detail as taught by Johnson for the purpose of securely holding and displaying an item within the container.

10. Claims 3, 6, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Drinon or Wittstein, each in view of Vance or Drinon or Wittstein, each in view of Johnson as applied to claims 1 and 7 in paragraph 8 or 9 above, and further in view of Young. Each of modified Drinon and Wittstein evidences all structure of the claimed tray except adhesive affixing two walls together (cls. 3 and 8) or decorative and shipment data indicia printed on the exterior of the container. Young teaches that it is known to bond two walls of a tray together and provide decorative and shipment indicia on the outside of a container for the purpose of mailing the tray as a gift. It would have been obvious to make the tray in either Drinon or Wittstein with adhesive fixing two walls together or with indicia on the outside of the box as taught by Young for the purpose of allowing the box to be mailed as a gift. Sealing of boxes and both mailing and decorative indicia on boxes are well known in this art.

11. Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claims 3 and 8 above, and further in view of pages 632 and 633 of the Wiley Encyclopedia of Packaging Technology (WEPT) publication. Modified Drinon and Wittstein evidence all structure of the claimed container except use of a rubberized adhesive as the adhesive on the tape. Pages 632 and 633 of the WEPT publication teaches that it is known to make box sealing tape with a rubberized adhesive. It would have been obvious to make the pressure sensitive tape in either modified Drinon or Wittstein with a rubberized adhesive as taught on pages 632 and 633 of the WEPT publication since a rubberized adhesive provides good sealing strength on kraft paperboard.

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12. Claims 13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claims 11 and 15 above, and further in view of Fushihara et al. Each of modified Drinon and Wittstein evidences all structure of the claimed container except a tray configuration capable of holding a golf ball four-pack. Fushihara et al teaches that it is known to make a tray (2) with a size to hold a golf ball four-pack, i.e. that it is known to make a tray of a size capable of holding a golf ball four-pack. It would have been obvious to make the tray in either modified Drinon or Wittstein with an interior size and shape to hold a golf ball four-pack as taught by Fushihara et al for the purpose of packaging golf balls. Sizing and shaping a box to hold a given desired content is considered prima facie obvious for one of ordinary skill in this art. The concept is self evident in nearly every box ever designed.

13. Claims 14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claims 12 and 16 above, and further in view of Fushihara et al. Each of modified Drinon and Wittstein evidences all structure of the claimed container except a tray configuration capable of holding a golf ball four-pack. Fushihara et al teaches that it is known to make a tray (2) with a size to hold a golf ball four-pack, i.e. that it is known to make a tray of a size capable of holding a golf ball four-pack. It would have been obvious to make the tray in either modified Drinon or Wittstein with an interior size and shape to hold a golf ball four-pack as taught by Fushihara et al for the purpose of packaging golf balls. Sizing and shaping a box to hold a given desired content is considered prima facie obvious for one of ordinary skill in this art. The concept is self evident in nearly every box ever designed.

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Conclusion

Due to the unclear construction of the embodiment set forth in claim 2, the prior art could not be properly applied thereto at this time. This should not be construed as an indication of allowable subject matter if corrected. Further consideration will be upon response by Applicant.

The remaining cited prior art is illustrative of the general state of the art.

In order to reduce pendency and avoid potential delays, Technology Center 3700 is encouraging FAXing of responses in Office Actions to (703)872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by Applicants who authorize charges to a PTO deposit account. Please identify the Examiner and art unit at the top of your cover sheet.

If in receiving this Office Action, it is apparent that certain documents are missing, e.g. copies of references cited, form PTO-892, etc., requests for copies of such papers should be directed to Errica Bembry at (703)306-4005.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist at (703)308-1078.

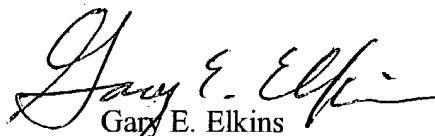
Any inquiry concerning this communication or earlier communication from the Examiner should be directed to Gary Elkins at telephone number (703)308-1034. The Examiner can normally be reached Monday, Tuesday and Thursday.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Lee Young can be reached at (703)308-2572.

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A handwritten signature in cursive script, reading "Gary E. Elkins".

Gary E. Elkins
Primary Examiner
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15 May 2004